REMARKS/ARGUMENTS

I. INTRODUCTION

Claims 21-68 are pending. By this amendment, claims 21, 29, 37, 45, 53 and 61 are amended to more particularly recite the automatic nature of the invention. Reconsideration is respectfully requested in view of the foregoing amendments and following remarks. Applicant respectfully submits that the Application is in condition for allowance.

II. THE REJECTION UNDER 35 U.S.C. § 101

On page 2 in section 3, the Office Action rejects claims 21-28 and 45-52 under 35 U.S.C. § 101, stating that the claimed invention is directed to non-statutory subject matter. Specifically, the Office Action states that "[c]laims 21-28 and 45-52 do not expressly recite that the computer program is executable; therefore, claims 21-28 and 45-52 are interpreted as software *per se*, which is non-statutory." Office Action, page 2. The Applicant respectfully traverses this rejection for at least the following two reasons.

First, Applicant respectfully submits that the Office Action improperly classifies claims 21-28 and 45-52 as being non-statutory "software *per se*." Applicant respectfully submits that the foregoing claims are, in fact, directed to a **statutory product**, i.e., "a computer-readable medium embodying a computer program." *See, e.g.*, the instant specification, page 7, lines 20-21. The Manual of Patent Examining Procedure (M.P.E.P.) generally provides that "Office personnel should classify each claim into one or more statutory or nonstatutory categories." M.P.E.P. § 2106(IV)(B). Moreover, the M.P.E.P. further states that "a claimed **computer-readable medium encoded with a computer program is a computer element** which defines structural and functional interrelationships between the computer program and the rest of the computer which permit the computer program's functionality to be realized, and is thus **statutory**." M.P.E.P. § 2106(IV)(B)(1)(a) (emphasis added); *see also* M.P.E.P. § 2106(IV)(B)(2)(a) ("A claim limited to a machine or manufacture, which has a practical application in the technological arts, is statutory."). Therefore, following the guidelines in the M.P.E.P., Applicant respectfully submits that claims 21-28 and 45-52 are improperly interpreted in the Office Action as "software *per se*."

Second, the Office Action states that claims 21-28 and 45-52 "do not expressly recite that the computer program is executable." Applicant respectfully submits that there is no statutory

requirement that a product claim directed to "a computer-readable medium embodying a computer program" *expressly* recite that the computer program is executable. As pointed out above, because a claimed computer-readable medium encoded with a computer program is a computer element which defines structural and functional interrelationships between the computer program and the rest of the computer which permit the computer program's functionality to be realized, Applicant respectfully submits that it is not necessary to expressly recite that the computer program is executable. *See* M.P.E.P. § 2106(IV)(B)(1)(a). Therefore, Applicant respectfully submits that claims 21-28 and 45-52 recite statutory subject matter under 35 U.S.C. § 101 and requests that the rejection be withdrawn.

III. THE REJECTION UNDER 35 U.S.C. § 112, FIRST PARAGRAPH

On pages 2-4 in section 5, the Office Action rejects claims 21-68 under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement. Specifically, the Office Action states that "[t]he claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention." Office Action, page 2. The rejection is respectfully traversed.

The first paragraph of 35 U.S.C. § 112 requires that the "specification shall contain a written description of the invention . . . ." This requirement is separate and distinct from the enablement requirement. *See, e.g., Vas-Cath, Inc. v. Mahurkar*, 935 F.2d 1555, 1560, 19 U.S.P.Q.2d 1111, 1114 (Fed. Cir. 1991). To satisfy the written description requirement, a patent specification must describe the claimed invention in sufficient detail that one skilled in the art can reasonably conclude that the inventor had possession of the claimed invention. *See, e.g., Moba, B.V. v. Diamond Automation, Inc.*, 325 F.3d 1306, 1319, 66 U.S.P.Q.2d 1429, 1438 (Fed. Cir. 2003); *Vas-Cath*, 935 F.2d at 1563, 19 U.S.P.Q.2d at 1116. Moreover, the examiner has the initial burden of presenting by a preponderance of evidence why a person skilled in the art would not recognize in an applicant's disclosure a description of the invention defined by the claims. M.P.E.P. § 2163(III)(A) (citing *In re Wertheim*, 541 F.2d 257, 263, 191 U.S.P.Q. 90, 97 (C.C.P.A. 1976)). For at least the following three reasons, Applicant submits that the Office Action fails to satisfy the initial burden of presenting by a preponderance of evidence why a

person skilled in the art would not recognize in an applicant's disclosure a description of the invention defined by the claims.

First, the Office Action states that it is not clear from the disclosure how the step of "electronically collecting [sic] tax data from a tax data provider," as recited in independent claims 21, 29, 37, 45, 53 and 61, is performed. Office Action, page 3, lines 1-2. Applicant respectfully disagrees and points to at least, for example, Figure 1 (step 12) as well as page 12, line 6 – page 13, line 1, which recites:

> In step 12, ***the electronic intermediary electronically collects tax data from the tax data providers using electronic links. The electronic intermediary connects electronically to each tax data provider that has tax data pertaining to the taxpayer using the electronic links.*** Referring to FIG. 2, the electronic intermediary 21 electronically connects to the taxpayer's employers 22 through electronic links 32, to the taxpayer's banks 23 through electronic links 33, to the taxpayer's brokerage firms 24 through electronic links 34, to the taxpayer's charities 25 through electronic links 35, to taxing authorities 27 through electronic links 37, and to the taxpayer's other tax data providers 26 through electronic links 36. FIG. 2 is illustrative, and the electronic intermediary 21 can connect electronically with and collect tax data electronically from other tax data providers, as discussed above in step 11.
>
> In FIG. 2, the electronic links 32-37 can be provided in a number of ways. ***Non-limiting examples of electronic links used to connect electronically the electronic intermediary and the tax data providers include: a general purpose computer electronically connected to telephone communication equipment using, for example, a modem or to an electronic data network, such as the Internet; or a computer-readable medium for transferring and receiving the tax data.*** (Emphasis added).

Thus, the electronic intermediary connects electronically to a tax data provider using at least one electronic link, and then, once connected, collects electronically tax data held by the tax data provider pertaining to the particular taxpayer. In view of the foregoing, Applicant respectfully submits that a person skilled in the art would, in fact, recognize in the instant specification a description of the invention defined by the claims, including the step of "collecting electronically tax data from said tax data provider," as recited in at least claim 21.

Second, the Office Action specifically points to claims 24-26, 32-34, 40-42, 48-50, 56-58, and 64-66, and, ostensibly, rejects the subject matter recited therein as not being sufficiently

described in the specification. *See* Office Action, page 3, lines 3-18. Applicant respectfully submits that the position taken in the Office Action appears to more closely resemble an indefiniteness argument, which is more appropriately addressed under the second paragraph of 35 U.S.C. § 112. *See* section IV below. Nonetheless, in order to fully respond to the Office Action, this point has been addressed here with regard to the written description requirement under section 112, first paragraph. In response, Applicant respectfully submits that a person skilled in the art would recognize in the instant specification a description of the invention defined by claims 24-26, 32-34, 40-42, 48-50, 56-58, and 64-66.

Claim 24, for example, recites that the "taxpayer specific tax data corresponds to at least one item of tax liability reported on at least one of an Internal Revenue Service ("IRS") form, a state form, a local form, and a foreign tax form." The Office Action states that "[i]t is not clear whether this limitation is meant to be a positive recitation of actively reporting data on an Internal Revenue Service ("IRS"), state, local, or foreign tax form or whether the limitation provides a mere clarification of the tax data as being the type of data that one would typically find reported on an Internal Revenue Service ("IRS"), state, local, or foreign tax form." Office Action, page 3, lines 3-6. In response, Applicant respectfully submits that this recitation should be properly construed to include taxpayer specific tax data which is typically found on IRS, state, local, and/or foreign tax forms. Support may be found in the instant specification at, for example, page 4, lines 14-19, which describes the type of data and information needed to compute tax liability for a taxpayer:

> This information includes: IRS Forms W-2 from their employers; IRS Forms 1099 from their banks; each mutual fund in which interests are held, each broker in respect of dividends, interest and gross brokerage proceeds, and other persons from whom payments are received; IRS Forms 1098 in respect of residential mortgage interest paid; and canceled checks or other acknowledgments from charitable organizations.

Claims 32, 40, 48, 56, and 64 include the same recitation and are, therefore, similarly supported in the instant specification. Moreover, the term "corresponds," recited in at least claim 21 and questioned in the Office Action at page 4, lines 7-19, supports this interpretation. Accordingly, Applicant respectfully submits that a person skilled in the art would, in fact, recognize in the instant specification a description of the invention defined by claims 24, 32, 40, 48, 56, and 64.

Likewise, claim 25 recites that the "at least one item of tax liability comprises at least one of income, gain, loss, deduction, wages, interest, dividends, capital gains, capital losses, residential mortgage interest, and taxes." The instant specification provides that a tax provider may provide each of these items of tax liability as tax data to the electronic intermediary. *See, e.g.*, Page 9, line 18 – page 10, line 2; page 13, lines 2-5. For example, with regard to wages as an item of taxpayer specific tax data related to tax liability, the taxpayer's employer may provide a payroll statement which generally includes items of tax liability such as, wages. *Id.* Claims 33, 41, 49, 57, and 65 include the same recitation and are, therefore, similarly supported in the instant specification. Accordingly, Applicant respectfully submits that a person skilled in the art would, in fact, recognize in the instant specification a description of the invention defined by claims 25, 33, 41, 49, 57, and 65.

Claim 26 recites that the "IRS form comprises one of an IRS Form 1040, an IRS Form 1040EZ, an IRS Form W-2, an IRS Form 1098, and an IRS Form 1099." The instant specification provides support for the varying types of IRS Forms at, for example, page 4, lines 1-2; page 4, lines 11-19; and page 14, line 18. Claims 34, 42, 50, 58, and 66 include the same recitation and are, therefore, similarly supported in the instant specification. Accordingly, Applicant respectfully submits that a person skilled in the art would, in fact, recognize in the instant specification a description of the invention defined by claims 26, 34, 42, 50, 58, and 66.

Third, the Office Action poses the following question: "[o]nce the tax data is received electronically from a tax data provider, how does the means for preparing electronically an electronic tax return know how to manipulate such data to perform the proper calculations necessary to complete the electronic tax return?" Office Action, page 3, lines 18-21. The focus of the inquiry is unclear, but, in order to move prosecution forward, the Applicant assumes that the Office Action is referring to claims 37-44 and 61-68 ("means for preparing electronically"). In response to the question posed in the Office Action, the Applicant respectfully submits that the instant specification sufficiently describes how the tax data is processed and used to prepare an electronic tax return. For example, the specification describes the tax data processing and tax return preparing steps 13 and 14, respectively, as follows:

> In step 13, the electronic intermediary processes the tax data obtained electronically from the tax data providers in step 12. In the present invention, ***step 13 can be implemented using a***

> ***computer program similar to the computer programs currently available in the market place, such as TurboTax, which is a registered trademark of Intuit, Inc. Although step 13 can be implemented with current technology, the current technology requires that the tax data and other information relevant to the taxpayer be inputted manually. With the present invention, this information is obtained as described above in steps 11 and 12.***
>
> Further, ***in step 13, the electronic intermediary processes the tax data by performing the appropriate tax computations.*** Non-limiting examples of appropriate tax computations include: addition, subtraction, multiplication, and division to determine the taxpayer's gross income, relevant deductions, net taxable income, and tax liability. As an illustration, the electronic intermediary compiles the home mortgage interest paid by the taxpayer and reported as tax data by the financial institutions to the electronic intermediary and determines the taxpayer's relevant deduction for the home mortgage interest paid to the financial institutions.
>
> In ***step 14, the electronic intermediary prepares electronic tax returns using the processed tax data from step 13. Similar to step 13, step 14 can be implemented using current technology.*** In practicing the invention, ***the electronic tax returns are prepared with respect to the particular taxing authorities***. For example, if the taxing authority is the IRS, the electronic tax return will correspond to the appropriate federal tax return, such as the Form 1040 or the Form 1040EZ.

Page 13, line 18 – page 14, line 18 (emphasis added); *see also* FIG. 1, blocks 13 & 14. The foregoing recitations describe how the electronic intermediary electronically prepares an electronic tax return using the processed tax data. Accordingly, a person skilled in the art would recognize in the instant specification a description of the invention defined by claims.

Furthermore, the Office Action states that "[b]ased on the disclosure in the specification, **the Examiner interprets the claim scope as embodying any means/method** for transferring data typically gleaned from a W-2, 1099, and 1098 form, in any format (and not necessarily inclusive of all of the data printed on the standard IRS version of each respective form), to prepare a tax return." Office Action, page 4, lines 1-6 (emphasis added). The Applicant respectfully disagrees with this interpretation of the claim scope. Claims 37 and 61, for example, recite an apparatus for automatic tax data collection by an electronic intermediary, the apparatus being defined by multiple means-plus-function clauses which must be construed by the Office

according to 35 U.S.C. § 112, sixth paragraph. Therefore, the terms in the means-plus-function clauses are limited to the corresponding structure(s) disclosed in the written description and equivalents thereof and **not** to "any means/method for transferring data typically gleaned from a W-2, 1099, and 1098 form, in any format, . . . to prepare a tax return," as asserted in the Office Action. In this case, the means for preparing electronically an electronic tax return using said processed tax data is supported and described at, for example, FIG. 1, blocks 13 & 14; FIG. 2, element 21; and page 14, lines 13-18.

In view of the foregoing arguments, the Applicant respectfully requests that the rejections under 35 U.S.C. § 112, first paragraph, be withdrawn.

IV. THE REJECTION UNDER 35 U.S.C. § 112, SECOND PARAGRAPH

On pages 5-7 in section 7, the Office Action rejects claims 21-68 under 35 U.S.C. § 112, second paragraph, as "being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention." Office Action, pages 4-5. The rejection is respectfully traversed. The Office Action uses, *in haec verba*, the same argument for both the section 112, first paragraph, written description rejection and the section 112, second paragraph, indefiniteness rejection. Applicant respectfully notes that these are two completely separate statutory standards of patentability having completely different requirements and underlying purposes. *See* M.P.E.P. § 2174. Nevertheless, because the Office applies the same reasoning to each rejection, the Applicant hereby incorporates by reference each of the arguments made above in section III of this response. Accordingly, and for the same reasons provided above, the Applicant respectfully requests that the rejections under 35 U.S.C. § 112, second paragraph, be withdrawn.

V. THE REJECTION UNDER 35 U.S.C. § 102

On pages 7-12 in section 9, the Office Action rejects claims 21, 22, 24, 29, 30, 32, 37, 38, 40, 45, 46, 48, 53, 54, 56, 61, 62, and 64 under 35 U.S.C. § 102(b) as being anticipated by the integration of MacInTax with Dollars & Sense, as disclosed in "A Marriage of Convenience" by Scott Beamer (hereinafter "Beamer"), and further supported by the article, "It's W-2 Time." The Applicant respectfully traverses the rejection.

35 U.S.C. § 102(b) states that "[a] person shall be entitled to a patent unless -

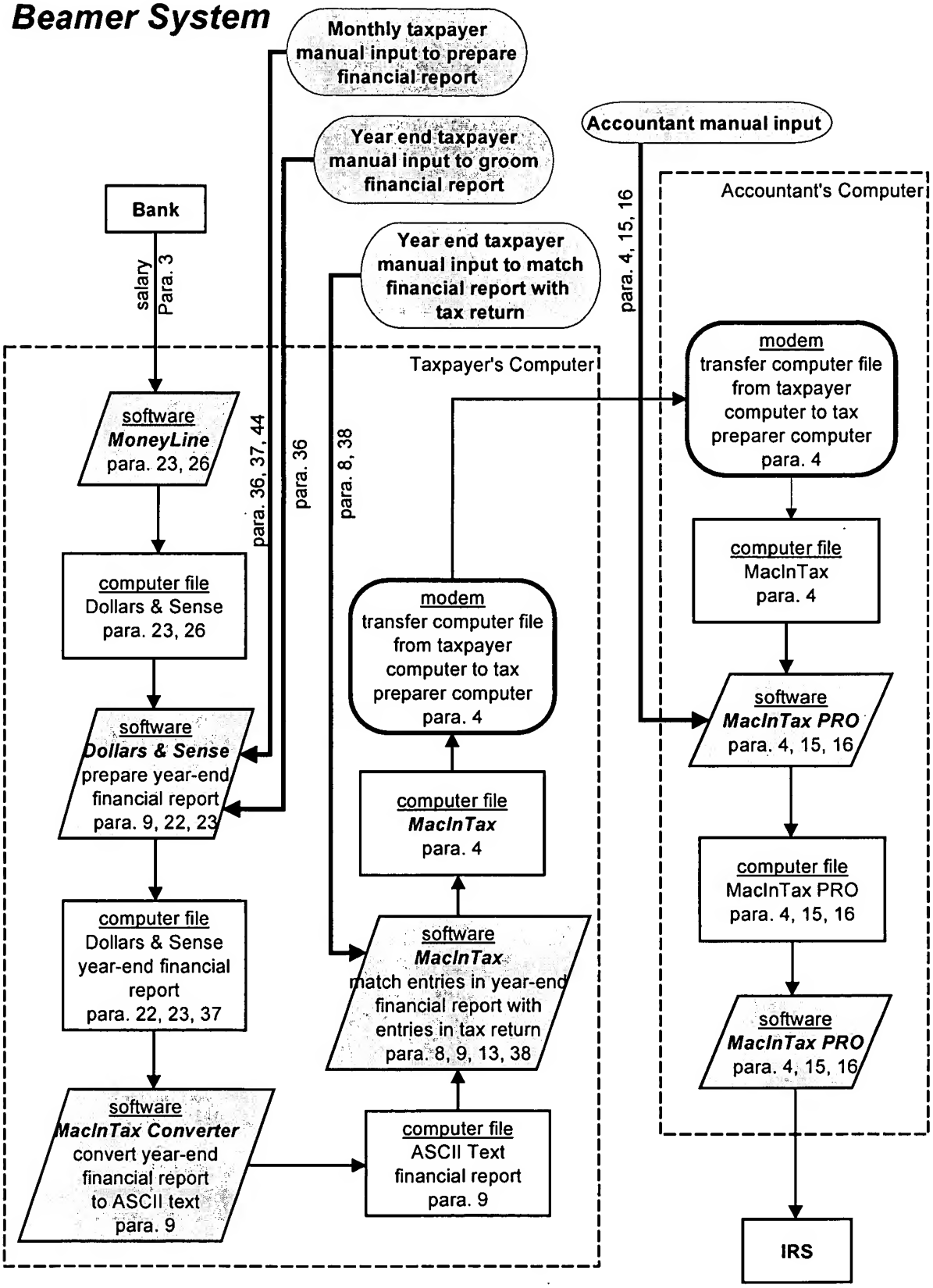
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States . . . .

"A claim is anticipated only if **each and every element** as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 U.S.P.Q.2d 1051, 1053 (Fed. Cir. 1987) (emphasis added); M.P.E.P. § 2131. Furthermore, "[t]he identical invention must be shown in as complete detail as is contained in the . . . claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 U.S.P.Q.2d 1913, 1920 (Fed. Cir. 1989).

The Applicant respectfully submits that the tax preparation methodology described in Beamer fails to teach each and every element as set forth in at least independent claims 21, 29, 37, 45, 53, and 61, as amended.

A. Beamer's Tax Preparation Methodology Using MacInTax

According to Beamer, preparation of a tax return using MacInTax requires four software programs (i.e., MoneyLine, Dollars & Sense, MacInTax Converter, and MacInTax). The following figure depicts the various software programs used according to Beamer and the flow of data through the Beamer system.


Beamer System
Monthly taxpayer manual input to prepare financial report
Year end taxpayer manual input to groom financial report
Year end taxpayer manual input to match financial report with tax return
Accountant manual input
Bank
salary
Para. 3
para. 36, 37, 44
para. 36
para. 8, 38
para. 4, 15, 16
Taxpayer's Computer
Accountant's Computer
software MoneyLine para. 23, 26
computer file Dollars & Sense para. 23, 26
software Dollars & Sense prepare year-end financial report para. 9, 22, 23
computer file Dollars & Sense year-end financial report para. 22, 23, 37
software MacInTax Converter convert year-end financial report to ASCII text para. 9
computer file ASCII Text financial report para. 9
software MacInTax match entries in year-end financial report with entries in tax return para. 8, 9, 13, 38
computer file MacInTax para. 4
modem transfer computer file from taxpayer computer to tax preparer computer para. 4
modem transfer computer file from taxpayer computer to tax preparer computer para. 4
computer file MacInTax para. 4
software MacInTax PRO para. 4, 15, 16
computer file MacInTax PRO para. 4, 15, 16
software MacInTax PRO para. 4, 15, 16
IRS

First, using the MoneyLine software program, the taxpayer transfers a bank record indicating a salary deposit for a taxpayer from a bank to a file readable by the Dollars & Sense software program. Beamer, ¶¶ 3, 23, 26.

Second, with the Dollars & Sense software program, which is a **personal finance management program**, the **taxpayer prepares monthly updates** of the Dollars & Sense file throughout the year and grooms (i.e., finally prepares) a year-end financial report of the Dollars & Sense file. Beamer, ¶¶ 9, 22, 23, 36, 37. Specifically, the taxpayer: (1) provides **monthly manual input** throughout the year to prepare a monthly financial report each month; and (2) provides **manual input** at **year end** to groom the financial report to prepare a year-end financial report for use in preparing a tax return. Beamer, ¶¶ 30-37. The Dollars & Sense software program does **not** automatically produce monthly financial report updates and the year-end financial report. Instead, a significant amount of **user manual input** is required by the taxpayer to **manipulate** the data from the bank into a form that is useable for determining taxes. This **user manual input** is done both **monthly** and at **year end**. *Id.* According to Beamer:

> If you want to be, [sic] more organized before you start, ***look at a few months*** of canceled checks and credit card receipts....
>
> It helps to have ***a couple months of entries*** up on the screen ***when you are entering transactions***....
>
> ***Little errors pop up frequently.*** If an error is major, say for instance you entered a deposit as a withdrawal or vice versa, the account won't balance and you'll know about it right away. Whenever your accounts don't balance, be careful not to save the unbalanced version over last month's balanced version....
>
> ***Grooming your files at the end of the year is a must.*** If your accounts balance at the end of the year, you are in pretty good shape but ***transactions can still be in the wrong categories. At tax time it is necessary to review all transactions one by one***, making sure that each is in the correct category and correctly marked as taxable or nontaxable. It is best to empty out the "Misc." and "Cash" accounts as much as possible.
>
> Hopefully, before tax time rolls around ***you have been practicing with report templates all year.*** This is the most difficult part of using these programs, especially with MacMoney, because there are so many variables to deal with. ***You must make a year***

> ***end report that will correctly summarize the tax data from your files.*** If you have been using the suggested tax accounts from the program, this shouldn't be too hard.
>
> ***If you balance your accounts even once a month***, in a few months a sense of order will begin to replace disarray....

Beamer, ¶¶ 31, 34-37, 44 (emphasis added).

Third, with the MacInTax Converter software program, the taxpayer converts the Dollars & Sense file for the year-end financial report into an ASCII text file. Beamer, ¶ 9.

Fourth, with the MacInTax software program, the taxpayer accesses the **ASCII text file** for the year-end financial report, **manipulates** the data in the report, and generates a MacInTax file with a tax return. Beamer, ¶¶ 8, 9, 13, 38. To produce the tax return, the MacInTax software program does **not** do this automatically. Instead, to produce the tax return, the taxpayer provides **manual input** to **match** entries in the ASCII text file of the year-end financial report with entries in the tax return. Beamer, ¶¶ 8, 38. According to Beamer:

> MacInTax (for 1986) already includes an interface that will allow it to open ASCII text files as a separate window from within MacInTax. ***You can select data in the window, then point to where you want the data entered in the tax forms***, permitting quick transfer of information from MacMoney to MacInTax.
>
> When it is time to prepare your taxes, open MacInTax and have it fill in the information from last year's forms automatically. Then open the interface window with the [ASCII] text file of your year end financial report. ***Move the data from the [ACSII] text file into the correct locations on the tax forms*** and your returns should be pretty well filled out.

Beamer, ¶¶ 8, 38 (emphasis added).

In further support of the **manual** requirements involved in Beamer's system, the Applicant also directs the Examiner's attention to Scott Beamer's book, MacInTax Made Easy, 1993, submitted previously in an information disclosure statement (IDS) on August 4, 2005, and which has the same author as Beamer. The following excerpts from MacInTax Made Easy further explain the extent of manual input required by a taxpayer in preparing his or her taxes using Beamer's system with regard to the steps recited in the instant claims.

Regarding converting and importing data into MacInTax to get ready for preparing tax forms, MacInTax Made Easy states:

> Some veteran users may also have prepared their personal financial management data for import into MacInTax. Now is the time to do it, if it seems worth it to you. The problem is that if your data file is in ASCII text, ***MacInTax will import it, but you must cut and paste each number to its appropriate line in MacInTax. The amount of manual effort this entails largely negates the advantage of importing***. Page 18 (emphasis added).

Next, regarding organizing personal records, including income, in preparing a tax return, MacInTax Made Easy states:

> Now it's time to organize your personal records. Hopefully, you have been using an electronic checkbook all year. Otherwise, ***you will have to put in some hard hours collecting, categorizing, and sorting your paper records***. Page 38 (emphasis added).

Regarding converting, importing and updating tax-related records in preparing a tax return, MacInTax Made Easy states:

> ***Anyone who tracks their personal or business finances on their Mac and uses MacInTax must dream of the day when they can fill out their tax return at the click of a button. A few are able to approach such simplicity now, but for most of us, it's a dream only partly fulfilled.***
>
> MacInTax can import two kinds of files (ASCII text and STD), and now has Publish and Subscribe fully operational for System 7 users. The ***question is whether it is more work to import the data or to just type it in, copying from a printed year-end report. Most still find that the easiest approach is to print out a year-end report in their personal financial management software and type the relevant information into MacInTax.*** Page 92 (emphasis added).

With regard to importing a Quicken® file in preparing a tax return, MacInTax Made Easy states:

> Those who use Quicken certainly have the option of printing out a tax summary report, then re-keying that information into MacInTax. However, Intuit has for years built a more elegant solution into Quicken. Your year-end report can be exported as an STD (Standard Tax Data) file. ***MacInTax can import an STD file and enter the information automatically in all the appropriate parts of your return.***

The negative side is that you must do considerable preparation for this to happen. Page 92 (emphasis added).

***

You may have noticed that ***all the effort involved in importing data from Quicken to MacInTax negates much of the advantage of using Import.*** While that's true, next year, and in the years to come, your efforts will pay big dividends. Quicken will remember how you assigned your Quicken categories for MacInTax, and you can skip this step entirely. Actually, ***you will probably have some editing to do***, but that shouldn't take too much time. Page 94 (emphasis added).

With regard to importing a MacMoney file in preparing a tax return, MacInTax Made Easy states:

If you used MacMoney to keep your financial records last year, ***you have three choices for getting that information into your tax return***. As with the other personal financial management software, the ***best choice is often to print out last year's category list*** after the first of the new year. The ***year-to-date totals for tax-related categories can then be typed by hand into MacInTax. This is the simplest method.***

You may wish instead to save to disk, as ASCII text, a tax summary report, such as the category list, which shows year-to-date totals for each category. You ***can then import this report into MacInTax and point and click to transfer amounts to the appropriate lines***.

Your ***third choice*** is to ***use the HyperCard stack*** that came on your original MacMoney disk. If for some reason you do not have this stack, you can download it from major bulletin boards or contact Survivor Software. It will prepare an STD file from your MacMoney data. In the HyperCard stack (shown in Figure 8-5), ***you will go through the process of pairing MacMoney categories with MacInTax categories***. The STD file can be imported by MacInTax and the information will flow directly to the correct places. Page 95 (emphasis added).

If you edit your data in MacMoney and want to send the edited version to MacInTax, the HyperCard stack will remember the pairings between your MacMoney categories and the MacInTax ones. It will prepare the new STD report at the click

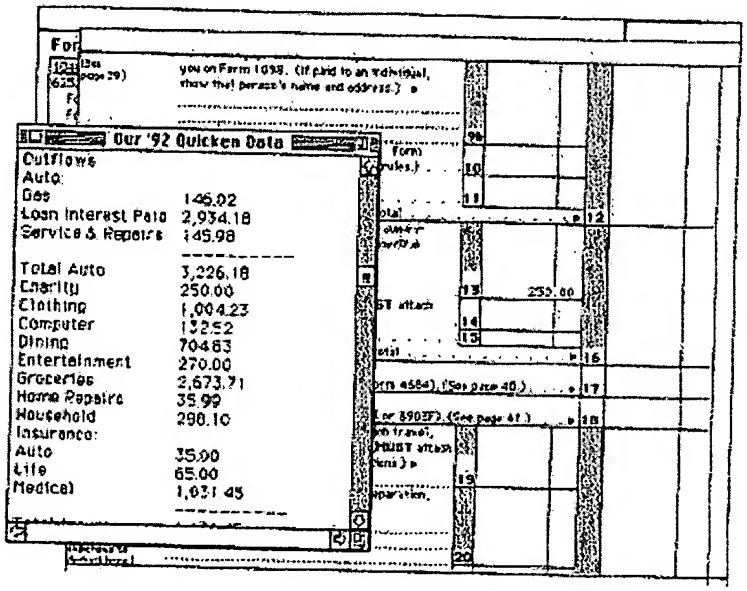
of a button. Disappointingly, this is not true from year to year. Next year, you will have to match up the categories again.

Whatever method you use to copy information from MacMoney to MacInTax, ***remember to verify the accuracy of your MacMoney data.*** Any inaccuracies there might migrate to your tax returns. Page 96 (emphasis added).

With regard to importing ASCII text files in preparing a tax return, MacInTax Made Easy states:

The problem is that ***MacInTax has no way of knowing where to put the dollar amounts from the text file. You will have to tell it by clicking on the dollar amount visible in the import window*** (as seen in Figure 8-6), ***then clicking on the line on a tax form to show MacInTax where to put the information***. This is a sort of streamlined Copy and Paste.

The question is, are you saving enough time and effort to justify the extra effort of the ASCII text export and import? One minor advantage of importing is that you may reduce the typos that might creep into your tax return if you re-key all the dollar amounts. Page 97 (emphasis added).



TaxMatch converts MacMoney data to STD
Figure 8-6.

For repeat users of MacInTax, with regard to transferring information filled out from last year's MacInTax return, MacInTax Made Easy provides:

It will fill in your name, address, social security number, filing status, dependents, and so forth with last year's information. ***It will not fill in your income and deductions with last year's***

> ***amounts, because these will almost certainly have changed.*** Page 108 (emphasis added).

Other relevant portions of the MacInTax Made Easy book similarly describe the additional amount of manual input and work required by a taxpayer in using the Beamer system to prepare a tax return.

The above description of Beamer's tax preparation methodology, including the several relevant excerpts from MacInTax Made Easy, highlights the extent of manual input and manipulation required in order for a taxpayer to process tax data and prepare a tax return using, *inter alia*, MacInTax (for 1986). This is in stark contrast to the method for "automatic" tax data collection according to the instant invention. For at least the following three reasons, Beamer fails to anticipate independent claims 21, 29, 37, 45, 53, and 61, as amended.

B. Beamer Fails to Teach or Suggest "Automatic Tax Data Collection by an Electronic Intermediary"

First, Beamer does not anticipate at least independent claims 21, 29, 37, 45, 53, and 61, as amended, because he fails to teach or suggest "**automatic** tax data collection by an electronic intermediary," as recited in each of these claims. The Applicant submits that such recitation in the preamble of each claim limits the recited steps and/or elements such that each recited step and/or element MUST be carried out **automatically**. In contrast to the claimed invention, Beamer teaches the type of **manual** tax preparation that the instant invention was intended to solve.

A properly construed definition of the term "automatic" and the limiting nature of its recitation in the claim preambles are, thus, significant in distinguishing between the claimed invention and the tax preparation methodology set forth in Beamer. The Applicant respectfully acknowledges that a computer can automate calculations involved in a data processing step, but notes that **Beamer's teaching of automation in one step does not necessarily import automation into other steps taught therein**.

1. The Preamble Limits the Claims

Although "automatic" is recited in the preamble, the preamble limits the claim. "The determination of whether a preamble limits a claim is made on a case-by-case basis in light of

the facts in each case; there is no litmus test defining when a preamble limits the scope of a claim." M.P.E.P. § 2111.02 (citing *Catalina Mktg. Int'l v. Coolsavings.com, Inc.*, 289 F.3d 801, 808, 62 U.S.P.Q.2d (BNA) 1781, 1785 (Fed. Cir. 2002)). "[A] claim preamble has the import that the claim as a whole suggests for it. In other words, when the claim drafter chooses to use both the preamble and the body to define the subject matter of the claimed invention, the invention so defined, and not some other, is the one the patent protects." *Bell Communications Research, Inc. v. Vitalink Communications Corp.*, 55 F.3d 615, 620, 34 U.S.P.Q.2d (BNA) 1816, 1820 (Fed. Cir. 1995) (emphasis in original). "If the claim preamble, when read in the context of the entire claim, recites limitations of the claim, or, if the claim preamble is 'necessary to give life, meaning, and vitality' to the claim, then the claim preamble should be construed as if in the balance of the claim." *Pitney Bowes, Inc. v. Hewlett-Packard Co.*, 182 F.3d 1298, 1305, 51 U.S.P.Q.2d (BNA) 1161, 1165 (Fed. Cir. 1999).

Further, "[a]ny terminology in the preamble that limits the structure of the claimed invention must be treated as a claim limitation." M.P.E.P. § 2111.02. The recitations in the preamble are considered structural limitations by reviewing the application in its entirety "to gain an understanding of what the inventors actually invented and intended to encompass by the claim." *Corning Glass Works v. Sumitomo Elec. U.S.A., Inc.*, 868 F.2d 1251, 1257, 9 U.S.P.Q.2d (BNA) 1962, 1966 (Fed. Cir. 1989).

On the other hand, "[i]f the body of a claim fully and intrinsically sets forth all of the limitations of the claimed invention, and the preamble merely states, for example, the purpose or intended use of the invention, rather than any distinct definition of any of the claimed invention's limitations, then the preamble is not considered a limitation and is of no significance to claim construction." M.P.E.P. § 2111.02 (citing *Pitney Bowes*, 182 F.3d at 1305, 51 U.S.P.Q.2d at 1166). "During examination, statements in the preamble reciting the purpose or intended use of the claimed invention must be evaluated to determine whether the recited purpose or intended use results in a structural difference (or, in the case of process claims, manipulative difference) between the claimed invention and the prior art." M.P.E.P. § 2111.02.

Here, the preamble of claim 21, for example, recites in its entirety: "A computer-readable medium embodying a computer program for automatic tax data collection by an electronic intermediary, said computer program." The body of claim 21 further recites "said electronic intermediary." By reciting **said** electronic intermediary in claim 21, the electronic intermediary

recited previously in the preamble of the claim is specifically being referenced. The situation for claim 21 here is the same as for claim 6 of the patent at issue in *Bell Communications*. In *Bell Communications*, the court noted that "said packet" in the body of claim 6 referred to the packet first introduced in the preamble and concluded that "said packet" expressly incorporated by reference the preamble recitation of "packet" into the body of the claim. *Bell Communications*, 55 F.3d at 621, 34 U.S.P.Q.2d at 1820. Following the reasoning in *Bell Communications*, the recitation of "said electronic intermediary" in the body, expressly incorporates by reference the preamble recitation of "automatic tax data collection by an electronic intermediary" into the body of claim 21.

Further, in the recitation of "automatic tax data collection by an electronic intermediary," the phrase "automatic tax data collection" is a structural limitation of the "electronic intermediary." In accordance with the reasoning in *Corning Glass Works*, a review of the instant specification in its entirety makes clear that "automatic tax data collection" is what was invented and intended to be encompassed by at least claim 21. *See, e.g.*, the instant specification, page 6, line 20 – page 7, line 1; page 13, lines 13-17. Thus, "automatic" is a limitation of each of the pending claims.

On the other hand, even if the preamble recitation of "automatic tax data collection by an electronic intermediary" is considered a purpose or an intended use of the invention, the recited purpose or intended use results in a manipulative difference between claims 21, 29, 37, 45, 53, and 61, as amended, and Beamer. As discussed above, Beamer fails to teach "**automatic** tax data collection." Thus, even if the preamble is considered a purpose or an intended use, the preamble limits the scope of the claim.

2. The Ordinary Meaning of "Automatic"

The instant specification does not recite a specific or special definition of the term "automatic." In such cases, a dictionary definition may be relied upon to determine the ordinary meaning of a claim term, so long as the dictionary definition is not contradictory with the specification. *See, e.g., Vitronics Corp. v. Conceptronic*, 90 F.3d 1576, 1584 n.6, 39 U.S.P.Q.2d (BNA) 1573, 1578 n.6 (Fed. Cir. 1996); *accord Phillips v. AWH Corp.*, 415 F.3d 1303, 75 U.S.P.Q.2d 1321 (Fed. Cir. July 12, 2005, as amended July 14, 2005). Webster's Third New International Dictionary, for example, has often been used by the Federal Circuit in cases

when there has been a "battle of the terms." *See, e.g., Omega Engineering, Inc. v. Raytek Corp*, 334 F.3d 1314, 1322, 67 U.S.P.Q.2d (BNA) 1321, 1326 (Fed. Cir. 2003) (using Webster's Third New International Dictionary 1681 (1993) to determine the ordinary meaning of "periphery."); *Desper Products, Inc. v. QSound Labs, Inc.*, 157 F.3d 1325, 1333, 48 U.S.P.Q.2d (BNA) 1088, 1094 (Fed. Cir. 1998) (using Webster's Third New International Dictionary 883 (1986) to determine the ordinary meaning of "following"). The Federal Circuit has also looked to technical dictionaries. *See, e.g., In re Thrift*, 298 F.3d 1357, 1364, 63 U.S.P.Q.2d (BNA) 2002, 2006 (Fed. Cir. 2002) (using the IBM Dictionary of Computing 638 (10th Ed. 1994) to determine the ordinary meaning of "speech user agent").

Webster's Third New International Dictionary (1976), for example, defines "automatic" in a first entry as "1 a : involuntary either wholly or to a major extent so that any activity of the will is largely negligible : of a reflex nature : without volition <the automatic blinking of the eyelids>," and in a second entry as "a machine or apparatus that operates automatically; *esp*: an automatic or autoloading firearm." Similarly, The American Heritage College Dictionary (3rd Ed., 1997) defines "automatic" as: "(1)(a) Acting or operating in a manner essentially independent of external influence or control." Moreover, Webster's II New College Dictionary (1999) defines "automatic" as: "(1)(a) Acting or operating in a manner essentially independent of external influence or control." In addition, Webster's II New Riverside Dictionary, Revised Edition (1996) defines "automatic" as: "(1) Operating or able to operate with little or no external control: self-operating or self-regulating."

The IBM Dictionary of Computing (10th Ed. 1994) defines "automatic" as: "pertaining to a process or device that, under specified conditions, functions without intervention by a human operator." Further, the IEEE Standard Dictionary of Electrical and Electronics Terms (3rd Ed. 1984) defines "automatic" as: "(3): (station control and data acquisition) pertaining to a process or device that, under specified conditions, functions without intervention by a human operator." Moreover, the McGraw Hill Dictionary of Scientific and Technical Terms (Fourth Edition 1989) defines "automatic" as: "[ENG] having a self-acting mechanism that performs a required act at a predetermined time or in response to certain conditions."

Furthermore, the Federal Circuit has previously construed the term "automatic" similar to the above dictionary definitions. Using Webster's II New Riverside University Dictionary 140 (1988), the Federal Circuit defined the term "automatic" as "1.a. Acting or operating in a manner

essentially independent of external influence or control. b. Self-regulating." *Space Systems/Loral, Inc., v. Lockheed Martin Corp.*, 243 F.3d 558, 2000 WL 1205154, *5 (Fed. Cir. 2000) (unpublished)[1]. In that case, the term "automatically" was recited in the claim body, and the Federal Circuit construed the claim based on the above dictionary definition of "automatic," stating, "we agree with Lockheed that **manual** initiation is antithetical to the concept of being **automatic**." *Id.* at *6 (emphasis added).

Thus, the foregoing cases and various dictionaries define the ordinary meaning of "automatic," such meaning being consistent with the use of "automatic" in the instant application. The term "automatic" must be given its ordinary meaning.

3. The Term "Automatic" Limits Each and Every Claim Limitation

The term "automatic," as recited in the preamble of claims 21, 29, 37, 45, 53, and 61, requires each and every step and/or element to be carried out automatically. This position is supported by a recent Federal Circuit Decision, *MercExchange, LLC v. eBay, Inc.*, 401 F.3d 1323, 1338, 74 U.S.P.Q.2d (BNA) 1225, 1237 (Fed. Cir. 2005), *petition for cert. filed*, 74 U.S.L.W. 3051 (U.S. July 25, 2005) (No. 05-130).

In the *MercExchange* case, the Federal Circuit was required to construe the term "automated" which appeared in the preamble. Prior to the appeal proceeding, the district court construed the preamble phrase "automated method, performed by a computer-based auction system" as not requiring that all the steps following the preamble be performed by an automated process. *Id.* The Federal Circuit affirmed the district court's interpretation that the recitation of "automated" in the preamble did not require each step in the body of the claim to be performed automatically because several limitations in the body of the claim expressly required actions by participants and, thus, could not be "automatically performed via an automated process." *Id.* In addition, the Federal Circuit affirmed that this interpretation was consistent with the specification. *Id.*

For example, claim 1 in the *MercExchange* case contained a limitation in the body of the claim requiring that the computer system "receive bids on the item from participants," which

[1] Non-precedential opinion; cited only for its persuasive value in demonstrating the reasoning of the Federal Circuit in construing the term "automatic." The Court's decision is referenced in a "Table of Decisions Without Reported Opinions" appearing in the Federal Reporter.

requires that participants enter their bids manually and cannot occur automatically. *Id.* Likewise, one step of claim 12 required that a seller "establish a seller's account." *Id.* The Federal Circuit similarly reasoned that this step requires that a seller manually enter relevant information into the system. *Id.* By construing the claims in such a manner, the Federal Circuit, thus, reasoned that for the term "automated" to be imported from the preamble into the body of the claim, each and every limitation in the body must be performed automatically, and not manually.

In contrast to claims 1 and 12 in *MercExchange*, the instant claims do **not** recite any steps or contain any elements that require manual intervention by the taxpayer, or any other human user or participant. Therefore, following the Federal Circuit's reasoning in *MercExchange*, **each and every** one of the various steps and elements in at least claims 21, 29, 37, 45, 53, and 61 must be construed as being conducted automatically. Moreover, the instant specification supports the interpretation that each step or element in the claims is intended to be carried out automatically. *See, e.g.*, the instant specification, page 13, lines 15-17.

Thus, in view of the Federal Circuit's reasoning in *MercExchange*, both the claims and the instant specification make clear that **every step** of the method as well as **every feature** of the product and apparatus, **as claimed**, are performed **automatically and electronically**.

4. The Term "Automatic" Must be Given Weight

The term "automatic" must be given weight. According to the M.P.E.P., "when evaluating the scope of a claim, every limitation in the claim must be considered. Office personnel may not dissect a claim into discrete elements and evaluate in isolation the discrete elements. Instead, the claim must be considered as a whole." M.P.E.P. § 2106(II)(C) (citations omitted) (emphasis in original).

As noted above in the *Lockheed* case, the Federal Circuit gave the recitation of "automatically" weight by finding noninfringement based on the claim construction of "automatically." *Space Systems/Loral, Inc., v. Lockheed Martin Corp.*, 243 F.3d 558, 2000 WL 1205154, *6 (Fed. Cir. 2000) (unpublished) ("[W]e agree with Lockheed that **manual** initiation is antithetical to the concept of being **automatic**."). Furthermore, in the *MercExchange* case discussed above, the Federal Circuit would have given the term "automated" weight, even though it was recited in the preamble, had the claim limitations permitted as much. Following

the reasoning of the Federal Circuit, if each limitation in the body of the claim is performed automatically, the recitation of "automated" is imported from the preamble into the body. *See* 401 F.3d at 1338, 74 U.S.P.Q.2d at 1237. Thus, following the Federal Circuit, and contrary to the position taken by the Office, the recitation of "automatic" in at least claim 21 must be given weight.

In sum, the Office cannot isolate the term "automatic" and, most certainly, cannot refuse to give the term "automatic" any patentable weight. The Office must give weight to the recitation of "automatic," both as to its ordinary meaning and its capacity to limit the claim scope.

5. Beamer Requires Manual Steps

Based on the foregoing definition of the term "automatic" and the following discussion of Beamer's tax preparation methodology using MacInTax, Beamer fails to teach "automatic tax data collection by an electronic intermediary," as recited in claims 21, 29, 37, 45, 53, and 61. Beamer teaches, for example, that the taxpayer must **manually collect** the data that was electronically obtained from the bank by: (a) **monthly manually updating** the Dollars & Sense financial report to balance the accounts (Beamer, ¶¶ 30-35, 37, 44); and (b) **year end manually "grooming"** the Dollars & Sense financial report by reviewing and editing each transaction one-by-one (Beamer, ¶¶ 36-37). *Cf.* MacInTax Made Easy, page 38. All of this **manual input** must be done by the taxpayer **prior to** the MacInTax software performing any tax computations for preparing a tax return.

Further, Beamer teaches that the taxpayer must **manually enter** the data onto the electronic tax return and into the taxpayer's computer. Beamer, ¶¶ 8, 38; *cf.* MaxInTax Made Easy, pages 18, 97. For example, in order to input data into locations on the MacInTax electronic tax form, Beamer teaches that the taxpayer must **manually select** the data from the Dollars & Sense year-end financial report (which was converted into ASCII text by the MacInTax Converter) and **manually point** to where the data should be entered on the MacInTax electronic tax form. Beamer, ¶¶ 8, 38; *cf.* MacInTax Made Easy, pages 18, 97. All of this **manual input** must be done by the taxpayer **prior to** the MacInTax software performing any tax computations for preparing a tax return. Thus, Beamer fails to teach "automatic tax data collection by an electronic intermediary." Beamer requires manual intervention to carry out at

least this step and, therefore, does not anticipate the claims. The citation to "It's W-2 Time" does not cure the deficiencies in Beamer.

C. Beamer Fails to Teach or Suggest "Collecting Electronically Tax Data from said Tax Data Provider"

Second, Beamer fails to teach or suggest "collecting electronically tax data from said tax data provider." The Office Action aligns this recitation in each of claims 21, 29, 37, 45, 53, and 61 with the downloading of information from a bank to the MacInTax software program via the Dollars & Sense software program, where the "downloaded information is used to assist in completing one's tax return," as taught by Beamer. Office Action, page 8, lines 5-9. The recitation of "collecting electronically tax data from said tax data provider" corresponds, for example, to step 12 in Figure 1. According to page 13, lines 13-17:

> Hence, ***with the electronic collection of tax data as in step 12***, the invention ***eliminates the current requirement*** that ***a taxpayer manually collect the tax data***, eliminates the current requirement that ***a taxpayer manually enter such tax data onto a tax return or into a computer***, and eliminates the need for all, or virtually all, intermediate hard copies of tax data, thereby saving paper, time, and cost. (emphasis added).

If the recitation of "collecting electronically tax data from said tax data provider, wherein said tax data is taxpayer specific tax data" were actually taught by Beamer, Beamer would **not** require (1) that **a taxpayer manually collect the tax data** and (2) that **a taxpayer manually enter such tax data onto a tax return or into a computer**. Specifically, Beamer first teaches that the taxpayer must **manually collect** the data that was electronically obtained from the bank by: (a) **monthly manually updating** the Dollars & Sense financial report to balance the accounts (Beamer, ¶¶ 30-35, 37, 44); and (b) **year end manually "grooming"** the Dollars & Sense financial report by reviewing and editing each transaction one-by-one (Beamer, ¶ 36-37). *Cf.* MacInTax Made Easy, page 38. All of this **manual input** must be done by the taxpayer **prior to** the MacInTax software performing any tax computations for preparing a tax return. Hence, Beamer fails to teach that taxpayer specific tax data collected electronically is not collected manually.

Further, in direct contrast to the instant invention, Beamer also teaches that the taxpayer must **manually enter** the data onto the electronic tax return and into the taxpayer's computer.

To move the data from the text file into the locations on the MacInTax electronic tax form, Beamer teaches that the taxpayer must **manually select** the data from the Dollars & Sense year-end financial report (which was converted into ASCII text by the MacInTax Converter) and **manually point** to where the data should be entered on the MacInTax electronic tax form. Beamer, ¶¶ 8, 38; *cf.* MaxInTax Made Easy, page 18, 97. All of this **manual input** must be done by the taxpayer **prior to** the MacInTax software performing any tax computations for preparing a tax return. In sum, Beamer teaches that tax data collected electronically is manually entered onto the electronic tax return and into the taxpayer's computer. Thus, Beamer fails to teach **automatically** "collecting electronically tax data from said tax data provider, wherein said tax data is taxpayer specific tax data," as required by the amended independent claims.

D. Beamer Fails to Teach or Suggest the Recited Tax Data

Third, Beamer fails to teach or suggest the recited **tax data**. Claim 21, for example, recites "collecting electronically tax data from said tax data provider, wherein said tax data is taxpayer specific tax data; processing electronically said tax data collected electronically from said tax data provider to obtain processed tax data; preparing electronically an electronic tax return using said processed tax data."

In applying Beamer, the Office Action aligns the recited tax data provider with a bank. Office Action, page 8, line 1 – page 9, line 8 (citing Beamer, ¶¶ 3, 4, 6, 15, 16, 23, 26). The taxpayer obtains the bank record on a monthly basis. Beamer, ¶ 3, 26. The monthly bank record of Beamer indicates a salary deposit of the taxpayer. Beamer, ¶ 3. The Office Action, thus, equates the downloaded bank record, which indicates the salary entry for the taxpayer, with the recited tax data. *See* Office Action, page 8, line 5 – page 9, line 8. The Applicant respectfully traverses this rejection and submits that the downloading of bank record with the indicated salary deposit is **not** "collecting electronically tax data from said tax data provider, wherein said tax data is taxpayer specific tax data; processing electronically said tax data collected electronically from said tax data provider to obtain processed tax data; and preparing electronically an electronic tax return using said processed tax data," as required by at least claim 21.

Contrary to the assertion in the Office Action, the bank record and the salary deposit indicated by Beamer are **not** tax data. Again, Beamer teaches that the bank record indicates the salary of the taxpayer. Beamer, ¶ 3. This salary entry in the bank record is the net pay of the

taxpayer. One of ordinary skill in the art of taxes would know that this salary entry, by itself, **neither** includes **nor** suggests the taxpayer's gross income, the tax withholdings taken from the taxpayer's gross income by the taxpayer's employer, and other deductions, such as, for example, retirement deductions, transportation deductions, and parking deductions, all of which are used to determine the taxpayer's taxable income. Further, one of ordinary skill in the art of taxes would know that, given that the employer withheld money from the taxpayer's income, the tax return including only the salary deposit indicated in the bank record of Beamer would be **incorrect** because that tax return would not include the taxpayer's taxable income. Only through **manual input**, then, could the taxpayer's taxable income be obtained. Hence, the downloaded bank record disclosed in Beamer, which indicates the salary deposit of the taxpayer, is **not** tax data because, by itself, the salary entry in the bank record cannot be used to prepare the tax return of the taxpayer. For this reason, banks provide their customers with IRS Form 1099 which indicates, for example, the amount of taxable interest income. Taxpayers are accordingly instructed to use the items in the IRS Form 1099 to determine their tax liability rather than using the information in their bank records.

As an example of such a bank account, the Applicant offers the bank record of the inventor David S. Miller (i.e., the 2004 Annual Statement Summary) and the Form 1099 from the same bank (i.e., the 2004 Tax Reporting Statement). *See* Attachments A & B. The 2004 Annual Statement Summary, for example, is a periodic (e.g., annual) bank record. On page 7 of this document, is a line item for "CMA NY Municipal Money" with a corresponding amount of $2,433.30. The 2004 Tax Reporting Statement, which is a tax bank statement (i.e., an IRS Form 1099), includes all of the amounts as reported on the 2004 Annual Statement Summary, except for the $2,433.30 because this amount represents the tax exempt NY municipal bond interest income, which does not appear on the IRS Form 1099 at all. Therefore, the 2004 Annual Statement Summary (i.e., periodic bank record) is **not** the same as the 2004 Tax Reporting Statement (i.e., tax bank statement). Using the Beamer system to generate a tax return based on the 2004 Annual Statement Summary would result in an **incorrect tax return** for the taxpayer. Thus, Beamer fails to teach or suggest tax data as recited in each of the independent claims.

For at least the three above-mentioned reasons, withdrawal of the rejection of claims 21, 29, 37, 45, 53, and 61 under 35 USC § 102(b) is respectfully requested. Claims 22, 24, 30, 32,

38, 40, 46, 48, 54, 56, 62 and 64 depend from at least one of the foregoing independent claims and are, therefore, allowable for at least the same reasons.

VI. THE REJECTION UNDER 35 U.S.C. § 103

On pages 12-15 in section 11, the Office Action rejects claims 23, 25-28, 31, 33-36, 39, 41-44, 47, 49-52, 55, 57-60, 63 and 65-68 under 35 U.S.C. § 103(a) as being unpatentable over Beamer and "It's W-2 Time" as applied to claims 21, 24, 29, 32, 37, 40, 45, 48, 53, 56, 61, and 64, further in view of Official Notice taken by the Examiner. *See* Office Action, page 13, line 7. The Applicant respectfully traverses the rejection.

With regard to claims 23, 25, 31, 33, 39, 41, 47, 49, 55, 57, 63 and 65, the Applicant respectfully submits that Beamer fails to teach or suggest the recited **tax data** for the reasons mentioned above. Furthermore, "It's W-2 Time" fails to cure this deficiency in Beamer. In any case, claims 23, 25, 31, 33, 39, 41, 47, 49, 55, 57, 63 and 65 properly depend from amended claims 21, 29, 37, 45, 53, and 61 and, thus, are allowable as being dependent on an allowable claim.

With regard to claims 26, 34, 42, 50, 58 and 66, the Office Action points out that "Beamer does not expressly teach that the bank account-related tax data is downloaded as data corresponding to an IRS Form 1099." Office Action, page 13, lines 5-6. The Applicant agrees with this admission for the same reasons provided above regarding Beamer's failure to teach or suggest the recited tax data. *See* Section V(D) above; Attachments A & B. The Office Action further asserts that "Beamer clearly lays the groundwork for electronically downloading tax-related data, such a bank statement data (i.e., data that is typically listed on an IRS Form 1099), and then using this data for automatically and electronically performing the calculations necessary to file an electronic tax return." Office Action, page 13, lines 12-16. The Applicant respectfully disagrees for at least two reasons.

First, as noted above, Beamer fails to teach or suggest the recited tax data, i.e., tax data corresponding to at least one item of tax liability reported on at least one of an IRS form, a state form, a local form, and a foreign tax form, the IRS form being one of an IRS Form 1040, an IRS Form 1040EZ, an IRS Form W-2, an IRS Form 1098, an IRS Form 1099.

Second, even assuming, *arguendo*, Beamer teaches the recited tax data, Beamer fails to teach that such tax data is collected and processed automatically, as now required in amended

claims 21, 29, 37, 45, 53 and 61. *See* Section V(B) above. In any case, claims 26, 34, 42, 50, 58 and 66 indirectly depend from amended claims 21, 29, 37, 45, 53, and 61 and, thus, are allowable as being dependent on an allowable claim.

With regard to claims 27, 28, 35, 36, 43, 44, 51, 52, 59 and 60, these claims properly depend from amended claims 21, 29, 37, 45, 53, and 61, and are submitted as being allowable for at least the same reasons.

For at least the above-mentioned reasons, withdrawal of the rejections under 35 USC § 103(a) is respectfully requested.

VII. DOUBLE PATENTING

On pages 16-17 in section 14, the Office Action rejects claims 21-68 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-18 of U.S. Patent No. 6,697,787 and claims 1-20 of U.S. Patent No. 6,202,052. Although the Applicant respectfully disagrees with the rejection, in order to speed prosecution Applicant submits herewith two terminal disclaimers in compliance with 37 C.F.R. § 1.321(c). Applicant further submits that the instant application and U.S. Patent Nos. 6,697,787 & 6,202,052 are commonly owned. Accordingly, the Applicant respectfully requests that the rejection be withdrawn and that the application is in condition for allowance.

VIII. CONCLUSION

In view of the above amendment and remarks, applicant believes the pending application is in condition for allowance. No fee is believed to be due for this amendment except for the three-month extension of time submitted herewith pursuant with 37 C.F.R. § 1.136. The Examiner is invited to call the undersigned should she believe that it will help speed prosecution. Reconsideration and prompt allowance are respectfully requested.

Respectfully submitted,

Date: October 3, 2005

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Attachments:

(A) 2004 Annual Statement Summary of David S. Miller

(B) 2004 Tax Reporting Statement of David S. Miller

MAS/RMF
DC2-684988